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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,392	10/17/2000	Ronald A. Katz	PAT-009C	3722
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MICHELLE A. ZARINELLI C/O WEST CORPORATION 11808 MIRACLE HILLS DR. MAIL STOP: W11-LEGAL OMAHA, NE 68154				
EXAMINER				
GORT, ELAINE L				
ART UNIT		PAPER NUMBER		
3687				
NOTIFICATION DATE		DELIVERY MODE		
06/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MAZARINELLI@WEST.COM

Office Action Summary

Application No.

09/691,392

Applicant(s)

KATZ ET AL.

Examiner

Elaine Gort

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23, 36, 39, 40, 42-50, 68-71, 75, 198-213 and 215-219 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23, 36, 39, 40, 42-50, 68-71, 75, 198-213 and 215-219 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/08/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 21-23, 39, 40, 43-46, 50, 68-71, 75, 198-211, 217 and 218 rejected under 35 U.S.C. 102(e) as being anticipated by Fano (U.S. Patent 6,317,718) in view of Siegel et al. (US 6,543,209) and Shaked et al. (US 2001/0034718).**

Fano discloses the claimed method for providing offers of a good, a service or information, utilizing an electronic communications device, between an offeror and a user of the electronic communication device (for example a PDA, see abstract), comprising the steps of:

Establishing communication via the electronic communications device between the offeror and user (for example communication is established between potential sellers and the user/buyer/shopper when it provides the user/buyer/shopper information about merchandise which the user/buyer/shopper has expressed interest in, see abstract);

Obtaining primary transaction data related to the primary transaction, the primary transaction data including user identity and user geographic descriptor data, (for example, column 31 lines 1+ disclose users providing identity data and "persona

locations" which relate to different contexts, such as work, home or vacation (cabin) addresses which include zip codes disclosed for example in column 30 lines 22+, additionally column 29 lines 25+ disclose users providing social security numbers and credit card information. Examiner is construing the location addresses as geographic descriptor data);

Using the identity of the user to determine at least one additional data element, (Such as the unique identifier disclosed in column 31 lines 4 to electronically identify a user and their "Personas" which relate to the rules related to items the user is interested in purchasing. Such as what type of airline ticket. If it is work related then certain rules apply, such as business or first class, but if personal then coach with non-refundable fares are preferred generally, see column 30 lines 22+);

Using the geographic descriptor of the user and the further data element to select among multiple items available for the geographic descriptor to determine an offer for a good, service or information; and offering the item to the user (for example the user identified by their username, password and unique identifier would be provided available flights that meet their specifications be it based on Home or Work);

But is silent regarding where the data element is a coded designator that is a combination of at least two of the user's attributes, and where one of the attributes is related to the user's confidential financial information.

Siegel et al. teaches, in column 5 lines 46-50, that it is old and well known in the art of data processing to use codes with multiple attributes to provide desired information with only one code.

Shaked et al. teaches, in paragraph [0081], that it is old and well known in the art of codes to use a code designator that is related to the user's confidential financial information (such as a customer's bank that is included in their credit card number) to provide information on a user's bank.

Therefore it would have been obvious to one having ordinary skill in the art of data processing and codes at the time the invention was made to provide the method of Fano with the codes with multiple attributes as taught by Siegel et al. and the code designator related to financial information as taught by Shaked et al., in order to provide desired information with only one code and provide information on a user's bank, respectively.

(Regarding wireless and phone) where the device is a wireless phone (a PDA is a wireless phone, PDA disclosed in abstract);

(Regarding contact of user) where the offeror system contacts the user via the electronic communications device (for example see figures 26 and 27);

(Regarding negative decision criteria) Determination of an offer is subject to negative decision criteria (for example, the user does not have to purchase offers made via the system. The Persona also includes negative decision criteria, for example when all airline tickets other than United are eliminated relating to Work as the buyer wants United flights, see column 30 lines 60+);

(Regarding visual offer) where the offer is made visually to the user (see visual display in Figure 27);

(Regarding purchase item information, claim 68) Where the primary transaction data includes data representing a specific good, specific service or geographic descriptor of the user (For example, the item the user/buyer/shopper is interested in purchasing, for example, be it a good at a mall, an airline flight or a restaurant, see abstract, column 26 line 64+ and column 31 lines 22+); and

(Regarding data used to select item to present, claim 217) Where the geographic descriptor, further data element and the identity of the user is used to select among multiple items available (For example the system uses the user's ID, Persona, and data relating to the good/service/information desired and also current location, to select among available items to only present items meeting the criteria based on this data. For example only provides airline ticket options that meet the required criteria based on this data, such as only presenting an airline ticket on United that is business class when the buyer is under the Work persona.).

3. Claims 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fano (U.S. Patent 6,317,718), Siegel et al. (US 6,543,209) and Shaked et al. (US 2001/0034718), as modified above, in view of Kolls (US Patent 6,389,337).

The combination of Fano, Siegel et al. and Shaked et al., as modified above, disclose the claimed method but is silent regarding the offer comprising a coupon (claim 36), and the offer being made orally to the user (claim 42). Kolls teaches that it is known in the art of e-commerce to use a wireless phone (312) to offer a coupon (see

Abstract line 13), where the offer is made orally to the user (via element 124) to provide an audible incentives for customers to accept the offers (for example customers that do not own PDA's but have cell phones). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of providing offers of the combination of Fano, Siegel et al. and Shaked et al., as modified above, with the offering of coupons orally as taught by Kolls, in order to provide an audible incentive for customers to accept offer. This is particularly advantageous for customers who have cell phones and not PDAs.

4. Claims 47-49, 212, 213, 215, 216, and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fano, Siegel et al. and Shaked et al., as modified above.

As to claims 47-49, the combination of Fano, Siegel et al. and Shaked et al., as modified above, shows all elements of the claims except the particular method of obtaining the geographic descriptor information. However, the examiner notes that the subject matter of claims 47-49 are obvious variants of the methods of obtaining the geographic descriptor data recited in claims 45 or 46. It would have been an obvious matter of design choice to use any of the methods recited in claims 47-49 since it is not disclosed that the particular method of obtaining the data solves any particular problem or is for a particular purpose, and it appears that the method would function equally well with either method.

It is noted that if it determined that the claimed subject matter is not merely an obvious variant, a species requirement would be necessary.

As to claims 47, 212, 213, 215, 216, and 219, the combination of Fano, Siegel et al. and Shaked et al., as modified above, fails to show utilizing data representing the identify of the user (e.g., a phone number via ANI) to obtain data representing the geographic position of the user.

Malackowski et al. teaches the use of advertising system that sends advertisement to user via wireless telephone utilizing AN1 data to determine a geographic identifier of the user (see column 11, lines 39-44).

It would have been 'obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fano, Siegel et al. and Shaked et al., as modified above, with wireless ANI data as taught by Malackowski et al, because utilizing a wireless phone extends the geographic range of communication between the user and the advertiser.

Regarding claims 48 and 49, Fano fails to expressly disclose a user or an operator manually entering geographic information.

The Examiner takes Official Notice that it was old and well known in the art at the time the invention was made to manually enter geographic identifying information by a user and an Operator.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Fano, Siegel et al. and Shaked et al., as modified above, with manually entered location data as is well known in the art,

because manually entering the location reduces the operating expense of the advertiser to provide the hardware and software required to electronically determine the location of a user.

Response to Arguments

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gart Matthew can be reached on 571/272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/
Primary Examiner, Art Unit 3687

May 30, 2008